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REEXAM UNIT

In re Reissue Application of  
Hirotoishi Ishida et al.  
Application No. 10/722,678  
Filed: November 28, 2003  
For: U.S. Patent No. 6,372,278

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: DECISION, *SUA SPONTE*,  
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: TO MERGE  
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: REISSUE AND  
:  
: REEXAMINATION  
:  
: PROCEEDINGS

In re Hirotoishi Ishida, et al.  
Reexamination Proceeding  
Control No. 90/007,164  
Filed: August 10, 2004  
For: U.S. Patent No. 6,372,278

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The above reissue and reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.565(d) at this time.

REVIEW OF FACTS

1. U.S. patent No. 6,372,278 issued on April 16, 2002, with 16 claims.
2. A request for reexamination was filed by a third party requester on August 10, 2004, and was assigned control No. 90/007,164 (hereinafter, the '7164 proceeding).

3. Reexamination was ordered for the '7164 reexamination proceeding on October 5, 2004.
4. An application for reissue, assigned application No. 10/722,678, was filed by the patent owner on November 28, 2003.
5. A patent owner's statement under 37 CFR 1.530 was not received in the '7164 proceeding.
6. Notification of the filing of the reissue application was published in the *Official Gazette* on February 10, 2004.
7. A Notice of Concurrent Proceedings under 37 CFR 1.565(a) was filed by the patent owner in the '7164 proceeding on January 13, 2005.

#### DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(d) :

"If a reissue application and an *ex parte* reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings."

As evidenced by the above review of facts, reissue application No. 10/722,678 and reexamination control No. 90/007,164 are currently pending. Since the order to reexamine has been mailed in the reexamination proceeding, a decision under 37 CFR 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately, at the same time, as to a particular patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner.

Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both proceedings. In making a decision on whether or not to merge the two proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

In order to provide efficient and prompt handling of the reissue and reexamination proceedings and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination proceeding will be merged in accordance with the decision set forth below.

It is to be noted, however, that the grant of merger of a reissue application and an *ex parte* reexamination proceeding under 37 CFR 1.565(d) **is discretionary**. *The present merger is not an assurance that, in a future similar situation, merger would be ordered.*

#### **DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS**

##### **I. Merger of Proceedings**

The above-noted reissue and reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

##### **II. Requirement for Same Amendments in Both Proceedings**

1. The patent owner is required to maintain identical amendments in the reissue application and the reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the proceedings remain merged. See 37 CFR 1.565(d).

2. A review of the reexamination file for reexamination control No. 90/007,164 shows that original patent claims 1-16 are present. A review of reissue application No. 10/722,678 shows that original patent claims 1, 3-6, and 10-16 are present, and original patent claims 2 and 7-9 are canceled. Original patent claims 1, 11, 13, and 15 are amended in the reissue application. **Accordingly, the claims are not identical in both proceedings.**

An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases, specifically, Application No. 10/722,678 and Control Number 90/007,164. The response to the requirement must be limited to placing the same amendments in all cases, and patent owner must **not** address any issue of patentability in the housekeeping amendment. It is to be noted that, pursuant to MPEP 2285, amendments in a merged proceeding for a reissue and reexamination are submitted in accordance with the reissue practice under 37 CFR 1.173.

III. Conduct of the Merged Reissue Application  
Examination and Reexamination Proceeding

1. After the appropriate housekeeping amendment (see Part II above) is received, or after the time for same expires, the examiner should promptly prepare an Office action for the merged proceeding.
2. In the event that a housekeeping amendment is not timely submitted, any claim which does not contain identical text in both proceedings should be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claims, and thus failing to particularly point out the invention.
3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. 305 relating to the conduct of *ex parte* reexamination proceedings, the merged examination will be conducted on the basis of

the rules relating to the broader, reissue-application examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. **However, periods of response should be set at TWO (2) months to comply with the statutory requirement for special dispatch in reexamination (35 U.S.C. 305).**

4. Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the reissue application and the reexamination proceeding. Each action will contain identifying data *for both of the cases, i.e., the reissue application and the reexamination proceeding*, and each action will be entered into both files (which will be maintained as separate files).
5. Any response by the applicant/patent owner must consist of a single response, with two copies being filed for entry in the two files, with each of the two bearing a signature. *Any such responses must be served on the requester*, who will also be sent copies of Office actions.
6. Pursuant to MPEP 2285:

"Amendments should be submitted in accordance with the reissue practice under ... 37 CFR 1.173; see MPEP § 1453."

Thus, the filing of any amendments to the drawings, specification, or claims must comply with the provisions of 37 CFR 1.173 and the guidelines of MPEP 1453. It is to be noted that 37 CFR 1.121 does not apply to amendments in a reissue application. Accordingly, clean copies of the amended claims are not required, *and such clean copies are not to be submitted*. Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the reissue application.

*Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

7. Where a paper is filed which requires payment of a fee (e.g., petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appeal brief, even though the brief relates to the merged multiple proceedings and even though copies must be filed (as pointed out above) for each file in the merged proceeding.
8. Upon return of the present merged proceeding to the examiner, the examiner (a) will review the files to insure that each file contains identical citations of prior patents and printed publications, and (b) will cite such documents as are necessary as part of the next Office action in order to place the files in that condition.
9. If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be terminated by the grant of the reissued patent, and the reissued patent will serve as the certificate under 37 CFR 1.570. See MPEP 2285.
10. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be dissolved. The reissue application will be held abandoned. The reexamination prosecution will be terminated and a reexamination certificate under 37 CFR 1.570 will be issued in accordance with the last action of the Office, unless further action in the reexamination proceeding is needed as a result of the difference in the rules relating to reexamination and reissue proceedings. If

further action in the reexamination proceeding is needed, any grounds of rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improperly broadened claims) would be made by the examiner, upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR 1.552(c).

11. If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceeding. Such examination would be conducted as set forth in the immediately preceding paragraph.

#### CONCLUSION

1. Reissue application No. 10/722,678 and reexamination control No. 90/007,164 are merged into a single proceeding.
2. Pursuant to Part II of this decision, a housekeeping amendment is required **within ONE MONTH of this decision**, placing the same amendments in all cases of the present merged proceeding.
3. The reissue and reexamination proceedings are being forwarded to the examiner via the Director of Technology Center 1700. Upon receipt of same, the examiner **should not issue an Office action for the present merged proceeding of the reissue and reexamination proceeding until after the earlier of** (a) the submission of the housekeeping amendment to place the same amendments in both cases or (b) the expiration of the ONE MONTH period from the mailing of this decision for filing the amendment.

4. All further examination in the merged proceeding should be conducted in accordance with Part III of this decision.
5. Telephone inquiries related to this decision should be directed to Elizabeth L. Dougherty, Senior Legal Advisor, at (571) 272-7733.



Kenneth M. Schor  
Senior Legal Advisor  
Office of Patent Legal Administration

June 15, 2005  
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